

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. In accordance with the election made in reply to the Restriction Requirement dated June 10, 2004, non-elected claims 6-29 and 31 have been canceled in this reply without prejudice or disclaimer.

Objections

The oath/declaration was objected to as defective for incorrectly stating the filing date of the foreign priority document for this application. An updated Application Data Sheet correcting the typographical error, together with a Notification of typographical error pointing out the typographical error contained in the originally filed Declaration, is enclosed. In accordance with 37 C.F.R § 1.76(d)(1), the information contained on the later filed Application Data Sheet governs the inconsistency between itself and the earlier filed Declaration. Accordingly, withdrawal of the objection is respectfully requested.

The drawings were objected to for containing reference numerals not mentioned in the specification. Paragraphs 0084, 0093, and 0105 of the specification and drawings 14A-D have been amended in view of these objections. The amendments are fully supported by the original specification and no new matter has been added. Accordingly, withdrawal of the objections is respectfully requested.

Rejections

Claims 1, 2, and 30 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent Application Publication No. 2002/0054259 (hereinafter “Funahata”) in view of U.S. Patent No. 5,759,616 (hereinafter “Michel”), Japanese Patent No. 03-149803 A (hereinafter “Tanaka”), and U.S. Patent No. 5,338,782 (hereinafter “Corley”). This rejection is respectfully traversed.

The present invention relates to methods of manufacturing an optical device and reflection plate, each of which is provided with a resin thin film having a micro-asperity pattern. Advantageously, the manufacturing methods of the present invention prevent the resin thin film from losing its shape through softening of the resin thin film in an alignment film forming process. As discussed with reference to an exemplary embodiment in the specification, this advantage is obtained even if the resin thin film is made of polyimide.

With respect to the cited prior art, none of Funahata, Michel, Tanaka, or Corley recognize the problems to be solved or the advantages being obtained by the present invention as recited in independent claims 1, 2, or 30. Moreover, the references are not related to one another, are not directed to solving similar problems, provide no suggestion or motivation to combine their teachings with one another, and, in some cases, are not in the same field of endeavor as the present invention. Thus, Funahata, Michel, Tanaka, and Corley, whether considered separately or in combination, necessarily cannot render the present invention as recited in independent claims 1, 2, or 30 obvious. Also, in view of

the lack of any teaching within the references themselves to combine each with the other, the combination of Funahata, Michel, Tanaka, and Corley is not proper.

Funahata relates to a liquid crystal display device having an effective function for reflective color display. Funahata explicitly lists the object of their invention as providing a diffused reflector from which the disadvantages of “(1) inferior reproducibility of the fine rugged pattern, (2) difficulty in patterning the reflecting film, (3) difficulty in forming a color filter on the reflecting film, and so forth” are removed. *See* Funahata, paragraphs 0006-0009.

Michel relates to a process for producing microstructure components on a substrate. Michel explicitly lists the object of their invention as providing “a method for the manufacture of the microstructure elements wherein the sensitive electronic circuits on the substrate are not damaged.” *See* Michel, column 2, lines 21-25.

Tanaka relates to a a stable thick film resistor having small TCR value and no offset by curing thermosetting resin to be used at a higher temperature than glass transition temperature after the resin is cured.

Corley relates to a thermosettable resin composition and to the enhancement of the processing properties of bismaleimides. Corley explicitly states that the objects of their invention are to provide new thermoset resin materials and to provide curable additives which reduce the melting and softening points of the bismaleimides yet cure to high-Tg, tough resins. *See* Corley, column 1, lines 35-40.

There is no suggestion in Funahata, Michel, Tanaka, or Corley as to why one skilled in the art presented with the teachings of Funahata would turn to Michel, Tanaka, or Corley. The same is true for all of the teachings of all of the respective references. Thus, because there is no indication expressing desirability to combine the teachings of Funahata, Michel, Tanaka, and Corley cannot be properly combined for 35 U.S.C. § 103 purposes.

The combination of Funahata, Michel, Tanaka, and Corley is improper because it would not be obvious to one of ordinary skill in the art to “pick and choose” select teachings from each of these references to arrive at the teachings of the claimed invention absent the present application as a guide and/or a suggestion/motivation to combine the references. In view of the above, it is clear that none of the references even contemplate the problem solved or advantage obtained by the present invention as recited in independent claims 1, 2, or 30, and fail to provide any motivation to combine their teachings.

The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used a*

guide in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

In view of the above, Funahata, Michel, Tanaka, and Corley (i) are not properly combinable, and (ii) whether considered separately or in combination, in view of their failure to recognize the problem solved or advantages obtained by the present invention, cannot render obvious the present invention as recited in independent claims 1, 2, and 30 of the present application. Thus, the independent claims 1, 2, and 30 of the present application is patentable over Funahata, Michel, Tanaka, and Corley. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 3 stands rejected under 35 U.S.C. §103 as being unpatentable over Funahata in view of Michel, Tanaka, and Corley, in further view of U.S. Patent No. 5,817,242 (hereinafter “Biebuyck”). This rejection is respectfully traversed.

For the same reasons as set forth above, the combination of Funahata, Michel, Tanaka, and Corley is improper. Biebuyck fails to provide any motivation to combine its teachings with the other references or supply the lacking motivation to combine the other references with each other as discussed above.

Biebuyck relates to a hybrid stamp structure for lithographic process and an elastomeric stamp for use in such a lithographic process. Biebuyck explicitly set forth the object of their invention as improving the method described by A. Kumar and G. M. Whitesides in 1993 “such that stamp lithography can compete with the current state-of-the-art lithography. Particularly, features of 0.1 to 1 microns width should be achievable

in a reproducible manner, suitable also for cover conventional wafer sizes.” *See* Biebuyck, column 1, lines 54-59.

There is no suggestion in Funahata, Michel, Tanaka, Corley, or Biebuyck as to why one skilled in the art presented with the teachings of Funahata would turn to Michel, Tanaka, Corley, or Biebuyck. The same is true for all of the teachings of all of the respective references. Thus, because there is no indication expressing desirability to combine the teachings of Funahata, Michel, Tanaka, Corley, and Biebuyck cannot be properly combined for 35 U.S.C. § 103 purposes.

The combination of Funahata, Michel, Tanaka, Corley, and Biebuyck is improper because it would not be obvious to one of ordinary skill in the art to “pick and choose” select teachings from each of these references to arrive at the teachings of the claimed invention absent the present application as a guide and/or a suggestion/motivation to combine the references. In view of the above, it is clear that none of the references even contemplate the problem solved or advantage obtained by the present invention as recited in independent claims 1, 2, or 30, and fail to provide any motivation to combine their teachings.

The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior

art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

In view of the above, Funahata, Michel, Tanaka, Corley, and Biebuyck (i) are not properly combinable, and (ii) whether considered separately or in combination, in view of their failure to recognize the problem solved or advantages obtained by the present invention, cannot render obvious the present invention as recited in independent claims 1, 2, and 30 of the present application. Dependent claims are patentable for at least the same reasons. Thus, the independent claims 1, 2, and 30 of the present application is patentable over Funahata, Michel, Tanaka, Corley, and Biebuyck. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 4 stands rejected under 35 U.S.C. §103 as being unpatentable over Funahata in view of Michel, Tanaka, and Corley, in further view of Japanese Patent No. 63-269347 A (hereinafter “Yamada”). This rejection is respectfully traversed.

For the same reasons as set forth above, the combination of Funahata, Michel, Tanaka, and Corley is improper. Yamada fails to provide any motivation to combine its teachings with the other references or supply the lacking motivation to combine the other references with each other as discussed above.

The purpose of Yamada is to prevent intrusion of air bubbles into a 2P cured resin by carrying out an operation of packing a photopolymer between a stamper and

transparent substrate in an inert gaseous atmosphere in a substrate molding method (2P method) of transferring a preformat part and pregroove part by using the photopolymer.

There is no suggestion in Funahata, Michel, Tanaka, Corley, or Yamada as to why one skilled in the art presented with the teachings of Funahata would turn to Michel, Tanaka, Corley, or Yamada. The same is true for all of the teachings of all of the respective references. Thus, because there is no indication expressing desirability to combine the teachings of Funahata, Michel, Tanaka, Corley, and Yamada cannot be properly combined for 35 U.S.C. § 103 purposes.

The combination of Funahata, Michel, Tanaka, Corley, and Yamada is improper because it would not be obvious to one of ordinary skill in the art to “pick and choose” select teachings from each of these references to arrive at the teachings of the claimed invention absent the present application as a guide and/or a suggestion/motivation to combine the references. In view of the above, it is clear that none of the references even contemplate the problem solved or advantage obtained by the present invention as recited in independent claims 1, 2, or 30, and fail to provide any motivation to combine their teachings.

The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must be a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must be an indication within the prior

art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

In view of the above, Funahata, Michel, Tanaka, Corley, and Yamada (i) are not properly combinable, and (ii) whether considered separately or in combination, in view of their failure to recognize the problem solved or advantages obtained by the present invention, cannot render obvious the present invention as recited in independent claims 1, 2, and 30 of the present application. Dependent claims are patentable for at least the same reasons. Thus, the independent claims 1, 2, and 30 of the present application is patentable over Funahata, Michel, Tanaka, Corley, and Yamada. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 5 stands rejected under 35 U.S.C. §103 as being unpatentable over Funahata in view of Michel, Tanaka, and Corley, in further view of U.S. Patent No. 6,075,652 (hereinafter “Ono”). This rejection is respectfully traversed.

For the same reasons as set forth above, the combination of Funahata, Michel, Tanaka, and Corley is improper. Ono fails to provide any motivation to combine its teachings with the other references or supply the lacking motivation to combine the other references with each other as discussed above.

Ono relates to a convex-micro-granular surface structure which is contributory to attenuation of reflectance and/or enhancement of light collection. Ono explicitly sets

forth objects of their invention as (1) to provide a lens with reduced surface reflectance as manufactured using a novel matrix improved in the above aspects for the transfer of a microgranular monolayer surface, (2) to enhance the light collection efficiency and expansion of the light-receiving area of a solar cell, (3) prevent the surface reflection of an optomagnetic recording medium, (4) to provide a photosensitive material having an antireflective function, (5) to prevent the reflection of irradiation light in the light path in the fabrication of an electronic circuit, and (6) to provide an expedient method and apparatus for imparting an antireflective function to a light-transparent material such as a photomask or the interface of substances constituting a laminate such as a photo-resist in the fabrication of an electronic circuit by optical means.

There is no suggestion in Funahata, Michel, Tanaka, Corley, or Ono as to why one skilled in the art presented with the teachings of Funahata would turn to Michel, Tanaka, Corley, or Ono. The same is true for all of the teachings of all of the respective references. Thus, because there is no indication expressing desirability to combine the teachings of Funahata, Michel, Tanaka, Corley, and Ono cannot be properly combined for 35 U.S.C. § 103 purposes.

The combination of Funahata, Michel, Tanaka, Corley, and Ono is improper because it would not be obvious to one of ordinary skill in the art to “pick and choose” select teachings from each of these references to arrive at the teachings of the claimed invention absent the present application as a guide and/or a suggestion/motivation to combine the references. In view of the above, it is clear that none of the references even contemplate the problem solved or advantage obtained by the present invention as recited

in independent claims 1, 2, or 30, and fail to provide any motivation to combine their teachings.

The Examiner cannot combine prior art references to render a claimed invention obvious by merely showing that all the limitations of the claimed invention can be found in the prior art references. Instead, there must a suggestion or motivation to combine the references within the prior art references themselves. In other words, regardless of whether prior art references can be combined, there must an indication within the prior art references *expressing desirability* to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis added). Further, the present application *cannot be used a guide* in reconstructing elements of prior art references to render the claimed invention obvious. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

In view of the above, Funahata, Michel, Tanaka, Corley, and Ono (i) are not properly combinable, and (ii) whether considered separately or in combination, in view of their failure to recognize the problem solved or advantages obtained by the present invention, cannot render obvious the present invention as recited in independent claims 1, 2, and 30 of the present application. Dependent claims are patentable for at least the same reasons. Thus, the independent claims 1, 2, and 30 of the present application is patentable over Funahata, Michel, Tanaka, Corley, and Ono. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or any other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 15115/018001).

Dated: _____

Respectfully submitted,

By  _____

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IN THE DRAWINGS:

Please amend the drawings as shown in the replacement sheet. Specifically, Figs. 14A-14D have been amended to change the reference numeral "3" to --3A-- for consistency with the specification. No new matter has been added by these amendments. Applicant respectfully submits that the replacement sheet is formal and encloses a separate letter to the official draftsman.